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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/744,315	06/25/2001	Y. Tom Tang	PF-0567 USN	5059

7590

09/26/2003

Incyte Genomics Inc
Legal Department
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EXAMINER

DIBRINO, MARIANNE NMN

ART UNIT

PAPER NUMBER

1644

DATE MAILED: 09/26/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/744,315

Applicant(s)

TANG ET AL.

Examiner

DiBrino Marianne

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-20 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: .

DETAILED ACTION

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in response to this action, to elect a single invention to which the claims must be restricted.

GROUPS I-VI

Claims 1, 2 and 13, drawn to a polypeptide/pharmaceutical composition thereof, comprising an amino acid sequence of one of SEQ ID NO: 1-6, and fragments and variants thereof having at least 90% amino acid identity.

Note Absent evidence to the contrary, each of the recited polypeptide sequences is distinct since each is a different protein with a different primary structure and is not obvious over the other proteins. Therefore, the instant claims 1, 2 and 13 encompass six GROUPS, not species.

GROUPS VII-XII

Claims 3-12, drawn to a polynucleotide, i.e., one of SEQ ID NO: 7-12, encoding the polypeptide of claim 1, i.e., one of SEQ ID NO: 1-6, and variants, thereof, and vector and host cell comprising said polynucleotide, and method for producing a polynucleotide using the said host cell, a polynucleotide which hybridizes to the polynucleotide of claim 3.

Note Absent evidence to the contrary, each of the recited polynucleotide sequences is distinct since each polynucleotide has a different structure and encodes a different protein having a different primary structure, and is not obvious over the other polynucleotides. Therefore the instant claims 3-12 encompass six GROUPS, not species.

GROUPS XIII-XVIII

Claim 14, drawn to an antibody that specifically binds the polypeptide of claim 1, one of SEQ ID NO: 1-6.

Note Absent evidence to the contrary, each of the recited antibodies is distinct since each has a different primary structure and a different antigen binding specificity, and is not obvious over the other antibodies. Therefore, the instant claim 14 encompasses six GROUPS, not species.

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GROUPS XIX-XXIV

Claim 15, drawn to an agonist of the polypeptide of claim 1, one of SEQ ID NO: 1-6.

Note Absent evidence to the contrary, each of the recited agonists is distinct since each has a different structure and a different specificity and mode of action, and is not obvious over the other agonists. Therefore, the instant claim 15 encompasses six GROUPS, not species.

GROUPS XXV-XXX

Claim 16, drawn to an antagonist of the polypeptide of claim 1, i.e., an antagonist of one of SEQ ID NO: 1-6.

Note Absent evidence to the contrary, each of the recited antagonists is distinct since each has a different structure and a different specificity and mode of action, and is not obvious over the other antagonists. Therefore, the instant claim 16 encompasses six GROUPS, not species.

GROUPS XXI-XXXVI

Claim 17, drawn to a method for treating or preventing a disorder associated with decreased expression or activity of HEPI, comprising administering the pharmaceutical composition of claim 13, i.e., comprising the polypeptide comprising one of SEQ ID NO: 1-6.

Note Absent evidence to the contrary, each of the methods is distinct since each uses a different polypeptide ingredient with a different structure, and is not obvious over the other methods. Therefore, the instant claim 17 encompasses six GROUPS, not species.

GROUPS XXXVII-XXXXII

Claim 18, drawn to a method for treating or preventing a disorder associated with increased expression or activity of HEPI, comprising administering the antagonist of claim 16, i.e., an antagonist of one of SEQ ID NO: 1-6.

Note Absent evidence to the contrary, each of the methods using each of the recited antagonists is distinct since each uses a different ingredient that has a different structure and a different specificity and mode of action, and is not obvious over the other methods. Therefore, the instant claim 18 encompasses six GROUPS, not species.

GROUPS XXXXIII-XXXVIII

Claims 19 and 20, drawn to a method for detecting a polynucleotide encoding the polypeptide comprising the amino acid sequence of one of SEQ ID NO: 1-6/fragments thereof, comprising use of the polynucleotide of claim 6, i.e., a polynucleotide having a sequence which is complementary to a polynucleotide encoding one of SEQ ID NO: 1-6.

Note Absent evidence to the contrary, each of the methods using each of the methods is distinct since each uses a different ingredient polynucleotide that has a different structure and detects a different polynucleotide, and is not obvious over the other methods. Therefore, the instant claims 19 and 20 encompass six GROUPS, not species.

2. The inventions listed as Groups I-XXXVIII do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

Claim 7 of the instant application does not provide a technical feature that is distinguished over the prior art, as evidenced by Zhao et al (Genomics 1997, cited in international search report for priority document PCT/US99/17107, and provided by Applicant). Zhao et al teach a polynucleotide comprising a polynucleotide sequence (xp5) of a fragment of SEQ ID NO: 7.

Therefore, the instant invention lacks Unity of Invention.

3. Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed.

4. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 C.F.R. § 1.48(b) and by the fee required under 37 C.F.R. § 1.17(h).

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5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marianne DiBrino whose telephone number is 703-308-0061. The examiner can normally be reached on Monday and Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Chan, can be reached on (703) 308-3973. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.



Marianne DiBrino, Ph.D.

Patent Examiner

Group 1640

Technology Center 1600

September 20, 2003



CHRISTINA CHAN
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